

Applicant: Marm
Serial No.: 09/910,355
Filed: July 20, 2001
Page 13 of 19

Remarks

As a preliminary matter, applicant acknowledges that claims 15-16 and 23-24 are free from the prior art. The only outstanding rejection of these claims is under 35 U.S.C. § 112, second paragraph. As discussed herein, applicant has presented claims 15-16 and 23-24 as new claims 41-44, respectively. Applicant respectfully submits that claims 41-44 are in condition for allowance, as discussed herein.

Claims 1-40 were pending. By way of this response, claims 1, 3, 19, 20, 24, 25, and 32 have been amended, and claims 41-47 have been added. Support for the amendments to the specification and the claims can be found in the application as originally filed, and no new matter has been added. Accordingly, claims 1-47 are currently pending.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-40 have been rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has amended the claims as set forth above to make more clear the subject matter being claimed. Applicant respectfully submits that, in view of the amendments to the claims, the rejection has been overcome.

Applicant: Mar
Serial No.: 09/910,355
Filed: July 20, 2001
Page 14 of 19

In view of the above, applicant submits that the claims satisfy the requirements of 35 U.S.C. § 112, second paragraph, and respectfully requests that the rejection of the present claims based on this statutory provision be withdrawn.

Claim Objections

Claim 3 has been objected to for not having a period. Claim 20 has been objected to for reciting the term "herein".

Claims 3 and 20 have been amended as suggested by the Examiner. Applicant respectfully submits that the amendments to the claims are sufficient to overcome the objections.

Rejections Under 35 U.S.C. § 102

Claims 1-14, 17, and 25-40 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by DE 2546692. Claims 1-14, 17, and 25-40 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Haralambopoulos et al. (U.S. Patent No. 5,598,233). Claims 19-22, 32-35, and 38-40 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Ridell (U.S. Patent No. 2,393,266). Claims 1-5, 7-14, 17-18, 25-27, 29-37, and 39-40 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Volk (U.S. Patent No. 5,347,326). Applicant traverses each of these rejections as it pertains to the present claims.

DE 2546692 appears to disclose a contact lens having a chamfered outer peripheral zone 42 near the peripheral edge of

the lens. The chamfered zone defines a flat or planar region (see Fig. 3) extending around the perimeter of the lens. The contact lens of DE 2546692 discloses a plurality of channels 43 located exclusively in the chamfered zone (i.e., in the flat region) of the lens. Importantly, the channels do not extend into the curved portion of the lens.

In contrast to the lenses of DE 2546692, the claimed lens of claims 1, 25, and 32 include microchannels that extend through at least a substantial portion of the curved peripheral zone of the contact lenses. In other words, the microchannels (i) extend into the curved peripheral zone and terminate in the peripheral zone, (ii) extend to the border of the peripheral zone and the optical zone, and/or (iii) extend into the optical zone. Providing microchannels in the curved peripheral portion of the contact lens, as recited in the claims, helps enhance effective tear exchange relative to lenses that only have channels around the perimeter, such as disclosed by DE 2546692. Thus, DE 2546692 does not disclose, teach or even suggest the presently claimed lenses.

In view of the above, applicant submits that the pending claims are not anticipated by, and are unobvious from and patentable over, DE 2546692 under 35 U.S.C. §§ 102 and 103.

Haralambopoulos appears to disclose contact lenses with slits 12 extending through both the anterior and posterior surfaces of the contact lenses. As discussed at column 4, lines 23-32, the "slit channels" are fluid passages extending through

both walls of the lens and forming a passage between the anterior and posterior surfaces of the lens.

The presently claimed lenses have microchannels that have a depth less than the thickness of the lens body. This is in contrast to the slits channels required by Haralambopoulos. To a large extent, Haralambopoulos actually teaches away from contact lenses with microchannels that have a depth less than the thickness of the lens body, as recited in the present claims.

Accordingly, applicant submits that the present claims are not anticipated by, and are unobvious from and patentable over, Haralambopoulos under 35 U.S.C. §§ 102 and 103.

Riddell appears to disclose contact lenses with channels 14 that do not extend to the peripheral edge of the contact lens (see Fig. 1, for example). Providing a lens with channels that are confined to the interior of the lens body, Riddell is able to create his desired vacuum when the eyelids close.

Riddell does not disclose, teach, or even suggest the present invention. For example, Riddell does not disclose, teach, or even suggest lenses including microchannels that extend from the peripheral edge towards the optical zone of the contact lens, as recited in the present claims. As discussed above, providing microchannels from the peripheral edge of the lens into the peripheral portion provides enhanced tear exchange. This is particularly evident relative to lenses that

Applicant: Marm
Serial No.: 09/910,355
Filed: July 20, 2001
Page 17 of 19

do not have channels extending to the peripheral edge, such as disclosed by Riddell.

In view of the above, applicant submits that the present claims are not anticipated by, and are unobvious from and patentable over, Riddell under 35 U.S.C. §§ 102 and 103.

Volk appears to disclose a contact lens that includes an anterior surface that is configured to maintain an eyelid in an open position to provide for diagnostic and therapeutic procedures of a patient (see column 12, lines 27-31, for example).

The presently claimed lenses have an anterior surface to accommodate movement of an eyelid over the anterior surface of the lens body. Lenses with the anterior surface as recited in the claims provide enhanced tear exchange due at least in part to the forces created by the eyelid acting on the contact lens. Because Volk's lenses are designed for therapeutic and diagnostic procedures, the anterior surface of Volk's lenses are not configured to accommodate an eyelid, and thereby do not obtain the benefits provided by the claimed lenses.

Because Volk does not disclose, teach or even suggest, a contact lens with an anterior surface to accommodate movement of an eyelid over the anterior surface, Volk does not anticipate the claims under 35 U.S.C. § 102 and does not render the claims obvious under 35 U.S.C. § 103.

Applicant: Marm
Serial No.: 09/910,355
Filed: July 20, 2001
Page 18 of 19

In view of the above, applicant submits that the present claims, that is claims 1-47 are not anticipated by DE 2546692, Haralambopoulos, Ridell, or Volk under 35 U.S.C. § 102(b). In addition, applicant submits that none of the prior art, alone or in any combination, suggest or provide a motivation to render the pending claims obvious under 35 U.S.C. § 103.

Each of the present dependent claims is separately patentable over the prior art. For example, none of the prior art disclose, teach, or even suggest the present lenses including the additional feature or features recited in any of the present dependent claims. Therefore, applicant submits that each of the present claims is separately patentable over the prior art.

Allowable Subject Matter

Claims 15-16 and claims 23-24 were indicated to be free from the prior art. Claims 15-16 and 23-24 have been rewritten in independent form as claims 41-44, respectively. Claims 41-44 are believed to be definite under 35 U.S.C. § 112, second paragraph.

In conclusion, applicant has shown that the present claims satisfy the requirements of 35 U.S.C. § 112, and are not anticipated by and are unobvious from and patentable over the prior art under 35 U.S.C. §§ 102 and 103. Therefore, applicant submits that the present claims, that is claims 1-47, are allowable. Therefore, applicant respectfully requests the Examiner to pass the above-identified application to issuance at

Applicant: Marn
Serial No.: 09/910,355
Filed: July 20, 2001
Page 19 of 19

an early date. Should any matters remain unresolved, the Examiner is requested to call (collect) applicant's attorney at the telephone number given below.

Date: May 15, 2003

Respectfully submitted,

Frank J. Uxa
Frank J. Uxa
Attorney for Applicant
Registration No. 25,612
4 Venture, Suite 300
Irvine, California 92618
(949) 450-1750
(949) 450-1764 Facsimile

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal service as first class mail with sufficient postage in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on: May 15, 2003

Frank J. Uxa
5/15/03